

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed April 25, 2006. At the time of the Final Office Action, Claims 1, 3, 6, and 8-10 were pending in this Application. Claims 1, 3, 6, and 8-10 were rejected. Claims 2, 4, 5, and 7 were previously cancelled without prejudice of disclaimer. Claims 1 and 3 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1 and 3 were rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended the Specification to overcome this rejection and have presented no new matter. Thus, Applicants respectfully request full allowance of Claims 1 and 3.

Claims 1 and 3 were rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 1 and 3 to overcome these rejections and respectfully request full allowance of Claims 1 and 3 as amended.

Rejections under 35 U.S.C. § 102

Claims 1, 3, 6, and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by PCT Application Publication WO 99/30028 and also filed as U.S. Patent 6,257,506 by Karl Hofmann et al. ("Hofmann"). Claims 1, 3-6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,470,548 issued to Shoji Ushimura ("Ushimura"). Claims 1, 3-6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,982,901 issued to Volker Holzgrefe ("901-Holzgrefe"). Claims 1, 3-6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,012,981 issued to Volker Holzgrefe et al. ("981-Holzgrefe"). Applicants traverse these rejections and submit that the cited references

fail to disclose a fuel injection valve as recited (with respect to Claims 1 and 3) or a gap from dampening the movement of the nozzle needle tip (with respect to Claims 6 and 8-10).

A. The Form of the Examiner's Rejections under 35 U.S.C. § 102(b) are Improper Because the Examiner Failed to cite Hofmann, Ushimura, 901-Holzgrefe and 981-Holzgrefe with Sufficient Specificity under 35 U.S.C. § 132 to Allow Applicants to Adequately Respond to the Rejections

The form of the Examiner's rejections under 35 U.S.C. § 102(b) are improper because the Examiner failed to cite Hofmann, Ushimura, 901-Holzgrefe and 981-Holzgrefe properly and with sufficient specificity under 35 U.S.C. § 132 and 37 C.F.R. § 1.104 to allow Applicants to adequately respond to the rejections. The Examiner's explanation for rejection of Claims 1, 3, 6 and 8-10. For example, according to 35 U.S.C. § 132, the PTO must notify Applicants of the reasons for rejecting *each* claim and provide such information and references as may be useful in judging the propriety of continuing the prosecution. In the present case, the Examiner did not set forth reasons for rejecting each of Claims 3 and 8-10 under 35 U.S.C. § 102(b).

Moreover, the Examiner further defeated the intent and purpose of 35 U.S.C. § 132 by failing to properly identify the portions of Hofmann, Ushimura, 901-Holzgrefe and 981-Holzgrefe that allegedly teach each of the limitations of Claims 1, 3, 6 and 10. The Examiner did not point to any particular portion of any of the references as purportedly teaching particular elements of Applicants' claims. For instance, with respect to Claim 1, the Examiner failed to cite any portion of any of the cited references that disclose a fuel injection valve that includes a nozzle needle with a nozzle needle seat that includes "a sealing edge provided between an outer surface of a conical nozzle needle tip and a frusto-conical body section of the nozzle needle... the outer surface of the conical nozzle needle tip provided directly adjacent the frusto-conical body section of the nozzle needle and each having essentially the same included angle" as recited in Claim 1. In fact, the Examiner failed to allege that any such limitations were disclosed in any of the cited references.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to cite Hofmann, Ushimura, 901-Holzgrefe and 981-Holzgrefe properly and with sufficient specificity to allow Applicants to adequately respond to the rejections under 35 U.S.C. § 102.

Thus, the Examiner has clearly failed to comply with 35 U.S.C. § 132. If the Examiner maintains rejections of the pending claims based on Hofmann, Ushimura, 901-Holzgreffe and 981-Holzgreffe, Applicants respectfully request that such rejections be sufficiently specific and included in a Non-Final Office Action, such that Applicants have an opportunity to adequately respond to rejections based on Hofmann, Ushimura, 901-Holzgreffe and 981-Holzgreffe.

B. Claims 1, 3, 6, and 8-10 are Not Anticipated by Hofmann, Ushimura, 901-Holzgreffe and 981-Holzgreffe

Assuming, *arguendo*, that the Examiner has set forth adequate reasons for rejection as contemplated by 35 U.S.C. § 132 (which the Applicants do not concede), rejected Claims 1, 3, 6 and 8-10 are not anticipated under 35 U.S.C. § 102(b).

Claims 1 and 3

Independent Claim 1 recites, among other elements, a fuel injection valve that includes a nozzle needle with a nozzle needle seat that includes “a sealing edge provided between an outer surface of a conical nozzle needle tip and a frusto-conical body section of the nozzle needle... the outer surface of the conical nozzle needle tip provided directly adjacent the frusto-conical body section of the nozzle needle and each having essentially the same included angle.” For instance, the in the Hoffman reference, conical section 12 and frustoconical section 22 are adjacent, but are do not have the same included angle. See Hoffman Figure 1. In the Ushimura reference, the nozzle needle tip 42 is offset from the frustoconical section 36 by a cylindrical section 38. See Figure 1. In both Holzgreffe references, the sealing seat 21 is offset from frusto-conical section 20 by a cylindrical section. See figures 1 and 3. As noted above, the Office Action cites no part of any of the cited references as teaching, either expressly or inherently, these recited elements, and the Office Action does not respond to similar arguments made in the previous Response to Office Action.

Accordingly, the cited references do not teach all of the elements of Claim 1 and, therefore, cannot anticipate Independent Claim 1 or Claim 3 that depends therefrom.

Applicants request reconsideration, withdrawal of the rejection under 35 U.S.C. § 102(b) and full allowance of Claims 1 and 3.

Claims 6 and 8-12

Independent Claim 6 recites a fuel injection valve that includes a nozzle body including a nozzle body seat and a nozzle needle with a nozzle needle seat, with a gap formed between the nozzle needle and the nozzle body “such that the gap is operable to hydraulically dampen movement of the nozzle needle seat toward the nozzle body seat.” However, the cited references do not disclose providing a gap designed for dampening of the motion between the nozzle body and the nozzle needle. In the Office Action, the Examiner asserts “the recitation such that the gap is operable to hydraulically dampen movement of the nozzle needle seat toward the nozzle body seat” merely required the ability/capability to operate in such a manner. The device of [each of the cited references] has the capability to operate in such a manner because the gap of [each reference] traps/contains part of the fuel flow.” The Examiner’s rejection, however, fails because each of the cited references fails to disclose the recited elements as necessarily present. To establish that a claim element is inherent in a prior art reference, extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.*

Accordingly, the cited references do not disclose all of the elements of Independent Claim 6. Applicants respectfully request reconsideration, withdrawal of the rejections under §102 and full allowance of Claims 6 and Claims 8-12 that depend therefrom.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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Limited Recognition No. L0225
Expires June 30, 2006
Limited Recognition Under 37 C.F.R. § 11.9(b)

Date: June 23, 2006

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